

Application No. 09/658,204
Reply to Office Action of December 29, 2005

REMARKS

Presently, claims 25-32, 34-36, 53, 61-63, and 70 are pending in the application.

Claim Rejection – 35 USC § 112, first paragraph

The Examiner has rejected claims 70, 25-29, 34, 53, 61-63 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner contends that “nothing in the specification indicates that the subscriber actuates the download of the customized EPG to the subscriber interface.” Applicant respectfully traverses this rejection.

Applicant respectfully directs the Examiner’s attention to at least three sections of the specification that describe the concept of “downloading a first customized EPG to a subscriber interface, wherein the downloading can be actuated by the subscriber,” as recited in independent claim 70.

For example, referring to page 4, lines 10-16:

[T]he STB [set-top box] may receive a plurality of EPG screens from a download server and, based on subscriber preferences and EPG interactions, select an appropriate EPG screen. Periodically, additional EPG screens may be sent to the set-top box from the download server offering more selections for the subscriber (i.e., each time the set-top box is powered-on).

Since a subscriber has the ability to turn the STB on, for example, the specification thus described that the subscriber may actuate the download of EPG screens.

A second example, at page 17, lines 16-21, further describes how the subscriber may actuate the download of a customized EPG:

At step 850, the STB selects the appropriate EPG screen to display based on the subscriber characteristics previously discussed. Furthermore, the STB may get profile information from the subscriber’s interactions to substitute the appropriate EPG screen for the individual subscriber and may select the appropriate EPG screen based on the profile information.

Therefore, by a subscriber indicating that he or she is a user having a profile different from the currently loaded profile, the subscriber actuates the download of an EPG customized for the new or altered profile.

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In a third example, on page 18, lines 15-19, a similar process is described:

It is to be noted that based on subscriber preferences, the download instructions may instruct the STB to select one of the EPG screens. As subscriber preferences/tastes change, the STB instructions appropriately instruct the STB to select a different EPG screen having different targeted advertisements.

In this example, the actuation is based on subscriber preferences, which may include the subscriber indicating that he desires the download of a new EPG or the subscriber indicating preferences which necessitate a new EPG. Therefore, based on the download instructions, a change of preference is an example of how the user actuates the download of a customized EPG.

Accordingly, the specification of the present application sufficiently describes the concept of "downloading a first customized EPG to a subscriber interface, wherein the downloading can be actuated by the subscriber," such that those skilled in the art would reasonably conclude that Applicant had possession of the invention of independent claim 70 (see MPEP 2163(I) and 2163.02). Reconsideration and withdrawal of the Examiner's § 112, first paragraph rejection are respectfully requested.

Prior Art Rejection – § 103(a)

The Examiner has rejected claims 70, 25, 27-28, 53, 61-63 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0020744 to Ellis *et al.* ("Ellis") in view of U.S. Patent Application Publication No. 2003/0208756 to Macrae *et al.* ("Macrae"). The Examiner contends that Ellis in view of Macrae discloses each and every element of the claimed invention. Applicant respectfully traverses this rejection.

Ellis teaches that "the program guide client requests listings from program guide server 25 and generates an appropriate program listings screen for display on display device 45 (FIG. 4)" (see paragraphs 64 and 68 of Ellis). Ellis teaches that the program guide client may store user preferences that allow viewers to customize their EPG. Ellis further teaches that the "...program guide client is implemented on user television equipment" (Abstract, second sentence).

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Macrae teaches improvements to EPGs including a "viewer profile analysis program," defining "hard pages" "differently in the sort screens," and changing panel ads "as the user moves from one category to the next..." Specifically, Macrae teaches that "if a user is viewing the Sports theme area, an ad for ESPN sports Center may appear, whereas a different ad was presented when the user was on the main grid" (see paragraph 281 of Macrae). This process displays a type of ad according to the theme area of the EPG displayed.

Independent claim 70 recites:

A method of delivering targeted advertisements in a customized electronic program guide (EPG), the method comprising:

- (a) characterizing one or more subscribers receiving an electronic program guide;
- (b) characterizing a plurality of advertisements to be transmitted to the subscribers;
- (c) creating at least one set of targeted advertisements by correlating the subscribers and the advertisements based on the subscriber characterizations and the advertisement characterizations;
- (d) creating at a subscriber node a plurality of customized EPGs based on the characterization of the one or more subscribers, wherein the subscribers have access to at least a portion of data used for the creation of the respective customized EPG, and wherein each customized EPG is associated with one of the at least one sets of targeted advertisements corresponding to the subscriber characterization on which that EPG is based;
- (e) downloading a first customized EPG to a subscriber interface, wherein the downloading can be actuated by the subscriber;
- (f) transmitting to the subscriber the ads in the at least one set associated with the first customized EPG;
- (g) detecting a change in the subscriber characterization;
- (h) downloading a second customized EPG to the subscriber interface in response to the detection of step (g); and

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(i) transmitting to the subscriber the ads in the at least one set associated with the second customized EPG. (emphasis added)

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references, when combined) must teach or suggest all of the claim limitations. See MPEP 2143.

The combination of Ellis and Macrae does not teach or suggest every aspect of the claimed invention because said combination fails to teach "creating at a subscriber node, a plurality of customized EPGs," as recited in claim 70. Ellis does not disclose creating customized EPGs at a subscriber node; instead, Ellis teaches customizing EPG's at the "program guide client" which is implemented "on user television equipment." Macrae also does not disclose this feature, since Macrae teaches that modification of EPGs takes place at a structure located at the subscriber television (e.g., a set-top box) (see Macrae, paragraphs 0040 and 0041). Further, no inference could be made by those skilled in the art when viewing both Ellis and Macrae that would teach or suggest creating EPGs at a subscriber node because neither reference teaches any suggestion of such action.

Since Ellis does not teach creating even a single customized EPG at a subscriber node, Ellis cannot teach downloading either a first or second EPG from the subscriber node to a subscriber interface. That is, Ellis teaches that EPGs are customized at the "program guide client." Ellis merely teaches that the program guide client requests listings from the program guide server, not that a plurality of customized EPGs is created at the subscriber node, from which one or more may be downloaded. Therefore, in Ellis, neither a single nor a plurality of customized EPGs are available for selection and/or download from a subscriber node to subscriber equipment. Ellis does also not teach or suggest that a second EPG is downloaded to the subscriber interface in response to a detected change in the subscriber characterization, since Ellis' system does not have multiple customized EPGs available for download. Macrae teaches that modification of EPGs takes place at a structure located at the subscriber television. Since no customized EPGs are created at the subscriber node, Macrae cannot teach downloading a customized

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EPG from the node to a subscriber interface. Further, no inference could be made by those skilled in the art when viewing both Ellis and Macrae that would disclose downloading a "customized EPG" because neither reference discloses any suggestion of such action.

Additionally, the combination of Ellis and Macrae fails to teach or suggest that "each customized EPG is associated with one of the at least one sets of targeted advertisements corresponding to the subscriber characterization on which the EPG is based." Ellis only teaches the creation of single EPGs at the program guide client. That is, in Ellis there is no teaching that various customized EPGs created according to subscriber characterizations and associated with corresponding ads are available for download from a subscriber node to a subscriber interface. Further, Macrae does not teach this aspect of associating each EPG of the plurality with a set of ads. Macrae teaches associating hard pages with ads. A hard page is not an EPG; "[a] hard page is defined as an area comprising 9 channel slots" (see paragraph 218 of Macrae). Neither of these references nor the combination thereof amounts to a teaching that "each customized EPG is associated with one of the at least one sets of targeted advertisements corresponding to the subscriber characterization on which the EPG is based."

Furthermore, the Examiner has not provided any teaching in either Ellis or Macrae that would provide a motivation to one skilled in the art to combine the references. Moreover, Ellis teaches customizing the program guide "based on the viewing histories, preference profiles, or any suitable combination thereof" (see paragraph 111). In contrast, Macrae teaches that ads corresponding to the category of "hard page" are displayed. Thus, since the two references suggest that ads correspond to contradictory items, Macrae teaches away from Ellis, and one skilled in the art would not look to the teachings of Macrae to alter Ellis.

Further, the combination of Macrae with Ellis changes the mode of operation of Ellis, and, therefore, the two references are not properly combinable. Ellis teaches that ads should correspond to viewer profiles, whereas Macrae teaches ads should correspond to the particular hard page viewed. Changing Ellis' system to target ads based on the

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hard page displayed would change the mode of operation of Ellis and defeats the primary purpose of Ellis of targeting ads base on viewer profiles, not the category of hard page.

Applicant respectfully submits that for the preceding reasons, Ellis and Macrae are not properly combinable references, and, even if combinable, such combination does not teach or suggest all features of independent claim 70. Therefore claim 70 is patentable over the suggested combination of Ellis in view of Macrae.

Dependent claims 25, 27-28, 53, and 61-63 are allowable at least by their dependency on independent claim 70. Reconsideration and withdrawal of the Examiner's § 103(a) rejection of claims 25, 27-28, 53, and 61-63 are respectfully requested.

The Examiner has rejected claims 26, 29-32, and 34-36 as being unpatentable over Ellis in view of Macrae and further in view of U.S. Patent Application Publication No. 2003/0145323 to Hendricks et al. ("Hendricks"). For the same reasons discussed above with respect to the Examiner's obviousness rejection over Ellis and Macrae, independent claim 70 is believed to be allowable over the combination of Ellis and Macrae. Applicant respectfully submits that Hendricks does not teach or suggest any of the elements missing from this combination. Thus, independent claim 70 is believed to be allowable over the combination of Ellis, Macrae, and Hendricks. Dependent claims 26, 29-32, and 34-36 are allowable at least by their dependency on independent claim 70. Reconsideration and withdrawal of the Examiner's rejection of claims 26, 29-32, and 34-36 are respectfully requested.

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Conclusion

In view of the foregoing remarks, Applicant respectfully submits that the Examiner's rejections have been overcome, and that the application, including claims 25-32, 34, 53, 61-63 and 70, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

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